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09/981,213	10/17/2001	Johan Renes	5117US	5776
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TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			EXAMINER GILLIGAN, CHRISTOPHER L	
			ART UNIT 3626	PAPER NUMBER
			NOTIFICATION DATE 01/25/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOMail@traskbritt.com

## Office Action Summary

Application No.

09/981,213

Applicant(s)

RENES ET AL.

Examiner

C LUKE GILLIGAN

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. In the amendment filed 11/5/07, the following has occurred: no claims have been added, amended, nor canceled. Now, claims 1-20 are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claim 9 has been amended to recite that the "two or more natural persons are a cohabiting same sex couple." Paragraph 0009 of the specification indicates that the described insurance policy could be applied to "a co-habitation agreement between a same sex couple." However, the remainder of the specification only describes the steps of claim 9, including "determining a periodic amount to be charged...", "charging that periodic amount...", and "administering the insurance program..." in the context of the ending of a marriage through divorce. Therefore, the specification as originally filed would not have enabled one of ordinary skill in the art to make and use the claimed invention of claim 9 as amended.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden,

**Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Official Notice.

7. As per claim 9, Golden discloses a method of doing business comprising: determining a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a contractual relationship between two or more natural persons (see paragraph 15); charging that periodic amount in an insurance program over a period of time (see paragraph 15); and administering the insurance program (see paragraphs 15 and 16). Golden does not explicitly teach that the disclosed "divorce insurance" applies to cohabiting same sex couples. However, the Examiner takes Official Notice that at the time of the invention it was old and well known in the art that some states permitted same sex marriage or same sex civil unions. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply the "divorce insurance" of Golden to a cohabiting same sex couple. One of ordinary skill in the art would have been motivated to apply the insurance in this manner for the purpose of helping to control the various costs of divorce (see paragraph 9).

8. Claims 1-8 and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Roberts, U.S. Patent No. 4,839,804.

9. As per claim 12, Golden discloses a method of doing business comprising: determining a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a contractual relationship between two or more natural persons (see paragraph 15); charging that periodic amount in an insurance program over a period of time (see paragraph 15); and administering the insurance program (see paragraphs 15 and 16). Golden does not explicitly teach that the financial consequences comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations thereof. Roberts teaches insurance to cover a child's education in the event of the death of a parent of the child (see column 3, lines 6-16). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine such coverage with the divorce insurance product of Golden. One of ordinary skill in the art would have been motivated to combine such coverage for the purpose of providing a form of child support as suggested by Golden (see paragraph 10 of Golden).

10. As per claim 1, Golden discloses the method of claim 12 as described above. Golden further discloses said natural persons are living together (see paragraph 15, the Examiner interprets a married couple to be "living together" as recited).

11. As per claim 2, Golden discloses the method of claim 1 as described above. Golden further discloses said natural persons are legally married (see paragraph 15).

12. As per claim 3, Golden discloses the method of claim 2 as described above. Golden further discloses said untimely ending comprises a divorce between the natural persons (see paragraph 15).

13. As per claim 5, Golden discloses the method of claim 1 as described above. Golden further discloses said insurance program is part of another contract (see paragraph 15, note that the divorce insurance is offered as a part of the company's legal insurance).

14. As per claim 8, Golden discloses the method of claim 12 as described above. Golden further discloses the prospective participant is one of the two or more natural persons (see paragraph 15).

15. As per claim 10, Golden discloses the method of claim 12 as described above. Golden further discloses limiting coverage for a certain time interval after the initiation of said contractual relationship (see paragraph 18).

16. As per claim 16, Golden discloses the method of claim 12 as described above. Golden further discloses the periodic amount charged one of the two or more natural persons is changed in view of changed circumstances in that natural person's life (see paragraph 18).

17. As per claim 18, Golden discloses the method of claim 12 as described above. Golden further discloses the periodic amount is a monthly amount (see paragraph 15).

18. As per claim 20, Golden discloses the method of claim 12 as described above. Golden further discloses means to prevent fraud (see paragraph 18, the examiner considers the time limit to avoid problems with "quickie divorces" to be a form of "means to prevent fraud" as recited").

19. Claims 4, 11, 14-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Roberts, U.S. Patent No. 4,839,804 and further in view of Covert, U.S. Patent Application Publication No. 2005/0038681.

20. As per claim 4, Golden discloses the method of claim 1 as described above. Golden does not explicitly disclose a combination of other financial risks with some financial consequences of the untimely ending of a contractual relationship between natural persons in said insurance program. However, Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons with other financial risks of the two or more natural persons (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to add coverage for additional financial risks of the two or more natural persons to the insurance program disclosed by Golden. One of ordinary skill in the art would have been motivated to add such coverage for the purpose of providing protection against additional expenses beyond those associated with the divorce itself (see paragraphs 0032-0033).

21. As per claim 11, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the charges for the periodic payments are paid by an entity not being one of the two or more natural persons in said contractual relationship. Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein the charges for the periodic payments are paid by an entity not being one of the two or more natural persons in said contractual relationship (see paragraph 0061). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such teachings from Covert into the method disclosed by Golden for the reasons given above with respect to claim 4.

22. As per claim 14, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's projected earnings. Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual

relationship between natural persons and wherein the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's projected earnings (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of tailoring premiums to characteristics of the participants (see paragraph 18 of Golden).

23. As per claim 15, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's partner's projected earnings. Covert teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's partner's projected earnings (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of tailoring premiums to characteristics of the participants (see paragraph 18 of Golden).

24. As per claim 17, Golden discloses the method of claim 16 as described above. Golden does not explicitly disclose that the change circumstances are selected from the listed group. Cover teaches an insurance program that covers some financial consequences of the untimely ending of a contractual relationship between natural persons and wherein changed circumstances are selected from the listed group (see paragraph 0036). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such

teachings from Covert into the method disclosed by Golden for the reasons given above with respect to claim 14.

25. Claims 6-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Roberts, U.S. Patent No. 4,839,804 and further in view of Mooney, **Could Insurers Find Bliss In Divorce Market ?** (paragraphs numbered by Examiner).

26. As per claim 6, Golden discloses the method of claim 1 as described above. Golden does not explicitly disclose providing a payment to the two or more natural persons at an end date of insurance coverage in the event the contractual relationship between the two or more natural persons does not end untimely. Mooney discloses a divorce insurance product that suggests providing a payment to married couples at an end date of insurance coverage in the event that the marriage does not end untimely (see paragraph 12). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a provision into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a provision for the purpose of providing an incentive to maintaining the marriage (See paragraph 12 of Mooney and paragraph 10 of Golden).

27. As per claim 7, Golden in view of Mooney disclose the method of claim 6 as described above. Golden does not explicitly teach a payment dependent on investment of the periodic amounts paid on behalf of said natural persons for said insurance policy. Mooney further discloses that the payment is dependent on investment of the periodic amounts paid on behalf of said natural persons for said insurance policy (see paragraph 12, note that Mooney suggests structuring this feature like a whole life policy). It would have been obvious to one of ordinary

skill in the art at the time of the invention to incorporate such a provision into the method of Golden for the reasons given above with respect to claim 6.

28. As per claim 19, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose investing at least a portion of the periodic amount. Mooney discloses investing at least a portion of a periodic amount paid for divorce insurance (see paragraph 12, note that Mooney suggests structuring this feature like a whole life policy). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a provision into the method of Golden for the reasons given above with respect to claim 6.

29. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Golden, **Breaking Up Without Going Broke** (paragraphs numbered by Examiner) in view of Roberts, U.S. Patent No. 4,839,804 and further in view of Flagg, U.S. Patent No. 6,456,979.

30. As per claim 13, Golden discloses the method of claim 12 as described above. Golden does not explicitly disclose the periodic amount to be charged a prospective participant is based, in part, on the prospective participant's age and the prospective partner's age. Flagg teaches an insurance policy that includes basing charge amounts on participant's age (see column 2, lines 13-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the method of Golden. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of tailoring premiums to characteristics of the participants (see paragraph 18 of Golden).

***Response to Arguments***

31. In the remarks filed 11/5/07, Applicants argue in substance that (1) paragraph 0009 of the specification is sufficient enablement for claim 9; (2) the rejections under 103 are improper because the level of ordinary skill has not been identified; (3) the taking of official notice is improper; (4) there is no reason to combine the teachings of Roberts's with the teachings of Golden; (5) Covert does not teach the limitations attributed to it with respect to claims 11, 14, and 15.

32. In response to Applicants' argument (1), as noted in the rejections under 112, first paragraph, although paragraph 0009 indicates that the insurance policy could be applied to "a co-habitation agreement between a same sex couple," there is nothing within the specification that would have enabled one of ordinary skill in the art to perform the steps of "determining a periodic amount to be charged a prospective participant for insurance covering at least some financial consequences of the untimely ending of a contractual relationship between a cohabitating same sex couple" as recited in claim 9. The specification does not apprise one of ordinary skill in the art what any such "financial consequences" would be. The specification also does not apprise one of ordinary skill in the art of how to "determine a periodic amount to be charged" to cover these unknown "financial consequences." Applicants have not pointed to any portion of the specification to support these deficiencies, therefore, the rejections under 112, first paragraph are maintained.

33. In response to Applicants' argument (2), if the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350,

1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001). See also MPEP 2141.03. In this case, it is respectfully submitted that the prior art cited, both by Applicants and the Examiner, clearly establishes the level of ordinary skill in the art. Therefore, the Examiner does not find this argument to be persuasive.

34. In response to Applicants' argument (3), it is unclear to the Examiner how Applicants are objecting the taking of Official Notice in the rejections. Applicants assert that it is improper and cite a portion of the MPEP but to not indicate why it is improper nor argue that the teaching which was asserted to be common knowledge was not in fact known at the time of the invention. Therefore, the taking of Official Notice is maintained.

35. In response to Applicants' argument (4), the Examiner respectfully maintains that one of ordinary skill in the art would have been motivated to combine the teachings of Golden and Roberts for the reasons given above in the rejections. In addition, it is noted that the proposed combination does not modify the teachings of either Golden or Roberts and that such a combination would have yielded predictable results. Therefore, the Examiner maintains that the combination is proper.

36. In response to Applicants' argument (5), it is respectfully submitted that Covert teaches a "purchaser" a providing payment for the policy. Covert does not teach that the "purchaser" need be the insured party. Therefore, Covert meets this negative limitation. Furthermore, Cover teaches that premiums are based on alimony, which, it is well known in the art, are based upon a couples projected earnings.

### ***Conclusion***

37. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

38. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C LUKE GILLIGAN whose telephone number is (571)272-6770. The examiner can normally be reached on Monday-Friday 8:30am-6:00pm.

40. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

41. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner, Art Unit 3626